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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,338	04/14/2005	Arnold Gieseke	11336968 (P02088US)	8213
81165 7590 09/18/2008 HARMAN - BRINKS HOFER INDY Brinks Hofer Gilson & Lione One Indiana Square Suite 1600 Indianapolis, IN 46204				
EXAMINER NGUYEN, CUONG H				
ART UNIT 3661		PAPER NUMBER		
MAIL DATE 09/18/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/531,338

**Applicant(s)**

GIESEKE, ARNOLD

**Examiner**

CUONG H. NGUYEN

**Art Unit**

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-6, 14, 17-19, 32-37 and 39-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-6 and 40-42 is/are allowed.
- 6) ☒ Claim(s) 14, 32, 37 and 39 is/are rejected.
- 7) ☒ Claim(s) 17-19, 33-36 and 43-45 is/are objected to.
- 8) ☒ Claim(s) 14, 17-19, 32-37 and 39, 43-45 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is the answer to the communication filed on 2/28/08 (and IDS), which paper has been placed of record in the file.
2. Claims 1-38 are pending in this application.

#### *Claim Rejections - 35 USC § 112*

3. Claims 7, 20, 27-31, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27-31 are directed a system; however, the examiner fails to see physical components that making up that system.

Applicant claims a navigation system; however, essential and critical components that making up that claimed system are not disclosed – this creates a big gap between structural relationships of components to practice this invention (i.e., a computer with microprocessors to perform a process (i.e., Figure 6), a route calculation module, a navigation server, a display

Claim 27 has a format problem (merely claiming a system with electronic signals – electronic signal is a natural/physical phenomenon):

As per claim 27: A navigation system comprising:

- **a first signal including a trip destination (merely claiming electronic signals)** that is transmittable to a navigation server from an input device, where a route calculation module is executable by the navigation server to generate a first route to the trip destination;
- **a second signal** transmittable from the navigation server to a display, where the display is operable to generate a graphical representation of the first route, where the first route is

generated on a road network map that includes a plurality of nodes and a plurality of segments, where an adaptive routing module executable by the navigation server allows a user to enter a user modification of the first route with the input device, where the user modification includes selection of at least map element, where a second route to the destination is calculatable with the adaptive routing module as a function of the user modification; and

- **a third signal** transmittable from the navigation server to a vehicle navigation system (

According to this invention, this 3<sup>rd</sup> signal is external to the claimed system – therefore, not a limitation of the claimed system), the vehicle navigation system operable to generate a second graphical representation of the second route on a display of the vehicle navigation system as a function of the third signal.

In other words, although there is nothing wrong to claim signals; however, pending claims are physical systems – other essential and critical components to make-up claimed system are required.

Claims 7, 20, and 38 are directed to a method, comprising steps to practice this claimed invention; however, these claims lack of disclosing of using a means to perform this claimed invention.

See a pertinent para.[0028] “*The vehicle navigation control unit 106 may be connected with a display 108. In one example navigation system 100, the display 108 may be a touch-screen display that functions as both a display and a user input device. In another example, the navigation control unit 106 may be connected with a user input device 110. The user input device 110 may be a keypad, a personal computer, a laptop computer, a pocket PC, a personal*

*digital assistant, a wireless access device or phone, or any other type of computing device that is capable of allowing a user of the vehicle navigation system 104 to input data during operation*".

It is suggested that "computer-implemented" is inserted in claimed preambles to overcome these 35 USC 112, 2<sup>nd</sup> para. rejections.

***Claim Rejections - 35 USC § 112***

4. Claims 32-36 is rejected under 35 USC 112, 1<sup>st</sup> para.

Claims 32-36 have a limitation of "means for calculating"; the examiner fails to see a best mode to practice this invention using a "means for calculating" (noting that a complete, concise, and clearly description of that claimed limitation (i.e., "means for calculating") must be provided to conform with disclosure's requirements).

5. Notes: About manner of claiming (at least for independent claim 27 containing 3 electronic signals):

According to MPEP,

- I. The definition of the matter for which protection is sought shall be in terms of the technical features of the inventions (i.e., a first signal, a second signal, and a third signal should not be protected technical features).
- II. Whenever appropriate, claims shall contain:
- III. I. A statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,
- IV. II. A characterizing portion – preceded by the words "characterized in that," "characterized by," "wherein the improvement comprises," or any other words to the

same effect – stating concisely the technical features which, in combination with the features stated under (I), it is desired to protect.

The claims must “define the matter for which protection is sought.” Claims must be clear and concise. They must be fully supported by the description. As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”). The physical requirements for the claims are the same as those for the description.

#### ***Election/Restrictions***

6. There are 2 different inventions involved based the language of pending claims. They are divided to 2 groups as the following:

- Group I: claims 1-6, 14-19, and 27-37 are directed to a navigation system (essentially comprises “physical” components/modules/devices/apparatus); class(es) 340/995.1, 995.19, 995.21.

- Group II: claims 7-13, 20-26, and 38 are directed to a method of generating routes in navigation systems (comprises “steps”), class(es) 701/209-210.

These are apparatus and process of use that apparatus claims.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, and the search for group I is not required for group II or for group III, restriction for examination purposes as indicated is proper.

7. Note: A well-known Internet website provides all claimed steps of claim 1

<http://www.mapquest.com> – it can calculate for routes that need a shorter travel time, or having a shorter total distance (i.e., including a modification from a user).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: [cuong.nguyen@uspto.gov](mailto:cuong.nguyen@uspto.gov)). The examiner can normally be reached on 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Art Unit: 3661

/CUONG H. NGUYEN/  
Primary Examiner  
Art Unit 3661